

### REMARKS

The specification has been amended to correct typographical errors, and to remove a reference to another application. The cross-related statement has been amended to correct the transposed serial number, and to further add titles and relevant issuance information for the respective patents. A clean version of all replacement paragraphs is found at pages 2-4. No new matter has been added. A marked-up version of the replacement paragraphs is found on pages 11-13 of this Reply.

Claims 23-30 are currently pending in the subject application and are presently under consideration. A clean version of all pending claims is found at pages 5-6. Claims 23-26 have been amended herein. No new matter has been added. A marked-up version of claim amendments made herein is found on pages 14-15 of this Reply. Claims 29 and 30 have been amended to correct the numbering.

Applicants' representative acknowledges the obligation under 37 CFR 1.56, as reminded by the Examiner, to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

#### **I. Rejection of Claims 23-24, 27-28 Under 35 U.S.C. § 102(b)**

Claims 23-24, 27-28 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bianco (U.S. Patent No. 5,407,614). Applicants' representative respectfully traverses this rejection and submits that it should be withdrawn for at least the following reasons. Bianco does not disclose each and every element recited in the respective claims.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference.” *Verdegaal Bros. v. Union Oil-Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 23, as amended, recites a method for delivering to a user a shopping list of items for selection by the user at a shopping facility, comprising generating a list of desired items at a location remote from the shopping facility, transmitting the list via an e-mail to a first computer, storing the list in a user data file on the first computer, retrieving the list at the shopping facility from the user data file using a kiosk which communicates with the first computer, and delivering the list to the user at the shopping facility in a user perceptible format.

Bianco does not fairly teach or disclose transmitting the list via e-mail to a first computer. Thus Applicants' representative respectfully requests that claim 23 be allowed, and claims 24-28 that depend therefrom.

## **II. Rejection of Claims 25, 29 Under 35 U.S.C. § 103(a)**

Claims 25 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bianco (5,047,614) in view of Roach *et al.* (5,310,997). To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, the Examiner must show some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art that would lead an individual to combine the relevant teaching of the references. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The court in *Fine* stated that:

Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 2008 USPQ 871, 8789 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined only if there is some suggestion or incentive to do so."

The M.P.E.P. adopts this line of reasoning, providing that:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

Bianco does not teach delivering a message to the user that identifies items that are out of stock. Further, in view of the reasons provided hereinabove in Section I with respect to amended independent claim 23, Applicants request that claim 25 be allowed.

Claim 29 recites an improved shopping facility comprising, at least one kiosk for generating a customer list of items to be purchased by each of a plurality of customers, a self-scanning system for permitting each of the plurality of customers to select items using a portable shopping terminal to maintain an updated list of selected items, and a plurality of checkout lanes for tendering payment of the items selected for purchase by the customer.

Bianco does not teach or fairly suggest that each customer can utilize a portable shopping terminal. Furthermore, Bianco does not teach or suggest a plurality of checkout lanes for tendering payment by the customer. It would require significant modification, not taught in the art, to combine the Bianco and Roach *et al.* in the manner suggested. Thus Applicants' representative submits that it would not have been obvious to one skilled in the art, and that claim 29 be should allowed. Since claim 30 depends therefrom, it should also be allowed.

### **III. Allowable Subject Matter**

Applicants' representative thanks the Examiner, and respectfully reserves the right to rewrite claim 30 in independent form at a later time.

**IV. Conclusion**

The present application is believed to be condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

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MARKED UP VERSION OF REPLACEMENT PARAGRAPHS

Please replace the paragraph on page 1, in the Cross-Reference to Related Applications with the following paragraph:

--This application is a continuation of U.S. Patent Application Serial No. 09/435,883 entitled "METHOD AND SYSTEM FOR PRESENTING ITEM INFORMATION USING A PORTABLE DATA TERMINAL" and that issued on March 13, 2001 as U.S. Patent No. 6,199,753, which is a divisional of U.S. Patent Application Serial No. 08/771,463 entitled "METHOD AND SYSTEM FOR PRESENTING ITEM INFORMATION USING A PORTABLE DATA" and that issued on November 9, 1999 as U.S. Patent No. 5,979,757, which is a continuation-in-part of U.S. Patent Application Serial No. 08/706,579 entitled "DEVICE AND METHOD FOR SECURE DATA UPDATES IN A SELF-CHECKOUT SYSTEM" and that issued October 20, 1998 as U.S. Patent No. 5,825,002, all of which are incorporated herein by reference. This application is also related to U.S. Patent Application Serial No. 08/780,023 entitled "INTRANET SCANNING TERMINAL SYSTEM" and that issued on July 4, 2000 as U.S. Patent No. 6,084,528.--

Please replace the paragraphs on page 4, lines 6-22 with the following amended paragraph:

--The information downloaded to the hand-held terminal can be presented in any number of forms. The data can be presented in the form of a still picture, text, audio or as video. As a result, a mechanic unknown to the manufacturer[manufacture] an open standard communications network and a generic hand terminal can download a video image of an engine part and a video clip for the part providing instructions on its removal and repair. The use of standard data protocols such as those used currently on the Internet permit wide area accessibility over commercial and closed communication networks on any number of hardware platforms.

A preferred alternative embodiment of the present invention includes machine readable coded labels having one or more remote file locations[location], such as uniform

resource[resurrect] locators (“URLs”)[(“URLS”)] used to reference sites on the World Wide Web[world wide web]. These URLs are use by the portable terminal to retrieve data files including items such as prices, nutritional data, coupon availability, promotions, marketing data and general interest data from various local and remote addresses available over a wireless communication network. The machine coded labels are preferably encoded with a high-density bar code such as PDF417. These URLs can be presented on the terminal display in the form of a hyperlink that[which] submits a data retrieval request to a remote address upon selection. The displayed hyperlink could be presented on the display as either a direct address (e.g., a URL) or a highlighted title for the address.--

Please replace the paragraph on page 8, lines 8-22 with the following amended paragraph:

--Collection of data is preferably performed by a bar code scanner 75. Preferably the scanner will be able to read one and two-dimensional[two dimensional] bar codes such as the ubiquitous UPC code and PDF 417 code. In an alternative embodiment of the present invention, the scanner is detachable from the terminal so that the terminal may be attached to a shopping cart with a shopping cart cradle and the scanner can be detached for use by the consumer. The scanner could be provided with either a short-range[short range] radio link and its own battery supply or a wired connection. In the event the products selected by the customer also bear electronic article surveillance (EAS) tags, the terminal may also be provided with a deactivation circuit which is activated when the product is scanned for purchase and deactivation prior to the product being delisted from the consumer's shopping list. [An example of such an activation/deactivating system is described in pending U.S. Patent Application No. 07/919,410 filed on July 27, 1992 which is assigned to Symbol Technologies, Inc.] The EAS tags are preferably used on a limited number of restricted sales items so that the EAS tags will be deactivated/activated only upon determination that the selected item is available for purchase by the customer at that specified time and place.--

Please replace the paragraph on page 9, lines 12-21 with the following amended paragraph:

--The ergonomic design of the portable terminal shown in Figure 2 permits a consumer to use the terminal in either horizontal configuration along line A-A, or in a vertical configuration relative to line A-A. The terminal is provided with a reconfiguration key setting that[which] permits the video system to automatically reconfigure its display to reflect the user's preference. The reconfiguration key 79A will automatically reconfigure the video display to change the display configuration from the first configuration, e.g., landscape, to a second configuration, e.g., portrait. The reconfiguration function permits a facility to connect the portable terminal to a fixed station in more than one arrangement. Thus, depending on space requirements, the portable terminal may be used as part of a kiosk[akiosk] to provide a fixed station for presenting pricing data, advertising and customer assistance.--

Please replace the paragraph on page 10, lines 3-13 with the following amended paragraph:

--Figures 4 and 5 illustrate an alternative embodiment of a portable terminal of the present invention. In Figure 4, terminal 100 is provided with a display 110. The display is a partial CGA display having a multi-contact navigational pad 106 for scrolling through the full video image presented to the consumer. In addition, the terminal 100 is also provided with a scanner 120 for reading bar code labels 122, three input buttons 101, 102 and 103, a speaker 104 and a microphone 105. The portable terminal 100 is equipped with a radio 108[radio108] and rechargeable battery 107 inside the casing, shown in Figure 5. Also shown in Figure 5 are the main circuit board 111, the scan engine 120A, and battery recharging terminals 107A and 107B that[which] are connected to a recharging circuit (not shown). A separate circuit board 109 is also shown for the optional telephony application. A battery overcharge protector circuit is also included but not shown.--

**MARKED UP VERSION OF AMENDED CLAIMS**

WHAT IS CLAIMED IS:

23. (Amended) A method for delivering to a user a shopping list of items for selection by the user at a shopping facility, [said method] comprising [the steps of]:

(a) generating a list of desired items at a location remote from the[said] shopping facility;

(b) transmitting the list via an e-mail to a first computer;

(c)[(b)] storing the[said] list in a user data file on the[a] first computer;

(d)[(c)]retrieving the list at the shopping facility from the user data file using a kiosk which communicates with the first computer; and

(e)[(d)]delivering the list to the user at the shopping facility in a user perceptible format.

24. (Amended) The method of claim 23, wherein the first computer which is used to generate the list is a user computer located outside the shopping facility, and the[said] list is communicated to the[said] kiosk through an electronic communication means.

25. (Amended) The method of claim 23, wherein step (d)[(c)] further comprises delivering a message to the user identifying items which are out of stock.

26. (Amended) The method of claim 25 further comprising the step[steps] of identifying alternative available products.



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29[32]. (Amended) An improved shopping facility comprising:

- at least one kiosk for generating a customer list of items to be purchased by each of a plurality of customers;
- a self-scanning system for permitting each of the plurality of customers to select items using a portable shopping terminal to maintain an updated list of selected items; and
- a plurality of checkout lanes for tendering payment of the items selected for purchase by the customer.

30[33]. (Amended) The system of claim 29[32] further comprising a shopping list distribution communication device for delivering the customer list presented on the kiosk to the portable terminal corresponding to the customer using the self-scanning system.